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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,689	11/18/2003	Jong Won Seok	51876P415	6616
8791 7590 06/27/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER WYSZYNSKI, AUBREY H				
ART UNIT 2134		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/716,689

**Applicant(s)**

SEOK ET AL.

**Examiner**

AUBREY H. WYSZYNSKI

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/18/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- Paper No(s)/Mail Date 5/31/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-15 are pending
2. The IDS of 05/31/05 was received and considered.

#### ***Double Patenting***

3. Claims 1-4 of this application conflict with claims 1 and 4 of Application No. 10/724,286. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/724,286. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Please see the chart below for a claim comparison.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Application 10/716,689	Application 10/724,286
1. An apparatus for controlling storage and playback of digital broadcasting contents in a transmitter of a digital broadcasting environment, comprising; an access control means for generating access control information for access control service and a control word; a copy control information (CCI) generation means for generating copy control information; a broadcasting flag (BF) generation means for generating broadcasting flag; a	1. A broadcasting server system for protecting and managing digital broadcasting contents, comprising: a control means for generating access control information and a control word based on subscriber information, the access control information including CAT, entitlement control message (ECM) and entitlement management message (EMM); an additional data generation means for generating additional data including use

<p>retention information (RI) generation means for generating retention information; a watermarking means for receiving the CCI, the BF and the RI and watermarking an uncompressed media signal with the CCI, the BF and the RI to thereby generate a watermarked media signal; a media encoding means for compressing the watermarked media signal; a multiplexing means for receiving and multiplexing the watermarked and compressed media signal, the access control information, the CCI, the BF, and the RI to thereby generate multiplexed transport stream; and a scrambling means for scrambling the multiplexed transport stream based on the control word and transmitting the scrambled transport stream.</p>	<p>control metadata, tool information metadata, and content purchase information metadata to protect and manage the digital broadcasting contents; a watermarking means for receiving an identification of a broadcasting content, which is referred to as a content ID, and the use control metadata, and watermarking an audio/video (A/V) media signal by using the content ID and the use control metadata as watermarks, the use control metadata including copy control information (CCI), broadcasting flag (BF) and retention information (RI); a media encoding means for compressing the watermarked A/V media signal; an encrypting means for encrypting the compressed A/V media signal; a multiplexing means for receiving and multiplexing the compressed and encrypted A/V media signal to thereby output a media transport stream; a re-</p>
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	<p>multiplexing means for receiving and re-multiplexing the media transport stream, the additional data and the access control information to thereby output a re-multiplexed signal; and a scrambling means for scrambling the re-multiplexed signal by using the control word.</p>
<p>2. The apparatus as recited in claim 1, wherein the CCI is information for determining whether a broadcasting content can be copied.</p> <p>3. The apparatus as recited in claim 1, wherein the BF is information for determining whether a content is a broadcasting content.</p> <p>4. The apparatus as recited in claim 1, wherein the RI indicates retention time of a broadcasting content when the broadcasting content is stored in a hard disk.</p>	<p>4. The system as recited in claim 1, wherein the use control metadata include the CCI, the BF and the RI, determines from the CCI whether a broadcasting content can be copied, identifies from the BF whether the content is a broadcasting content, and indicates in the RI how long the broadcasting content can be retained being stored in a hard disk of the receiver.</p>

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-15 rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski et al. US 6,157,719.

Regarding claim 1, Wasilewski discloses an apparatus for controlling storage and playback of digital broadcasting contents in a transmitter of a digital broadcasting environment (fig. 6, #607), comprising;  
an access control means (col. 6, lines 24-55) for generating access control information for access control service and a control word (col. 6, lines 32-37);

a copy control information (CCI) generation means for generating copy control information (col. 31, lines 24-25);

a broadcasting flag (BF) generation means for generating broadcasting flag (fig. 17, #1705);

a retention information (RI) generation means for generating retention information (col. 31, lines 13-30 and 48-53);

a watermarking means (encoding a packet identifier) for receiving the CCI, the BF and the RI and watermarking an uncompressed media signal with the CCI, the BF and the RI to thereby generate a watermarked media signal (col. 31, lines 13-30);

a media encoding means for compressing the watermarked media signal (fig. 7, #704 and fig. 4, #327, col.18, lines 52-67);

a multiplexing means for receiving and multiplexing the watermarked and compressed media signal, the access control information, the CCI, the BF, and the RI to thereby generate multiplexed transport stream (col. 18, lines 36-51); and

a scrambling means for scrambling the multiplexed transport stream based on the control word and transmitting the scrambled transport stream (encryption, col. 2, lines 43-47 and col. 18, lines 62-67).

Regarding claims 2-4, Wasilewski discloses apparatus as recited in claim 1, wherein the CCI is information for determining whether a broadcasting content can be copied (col. 31, lines 23-24), wherein the BF is information for determining whether a content is a broadcasting content, wherein the RI indicates retention time of a broadcasting content



when the broadcasting content is stored in a hard disk (col. 31, lines 13-30 and 48-53).

Regarding claims 5 and 10-11, Wasilewski discloses apparatus for controlling storage and playback of digital broadcasting contents in a receiver of a digital broadcasting environment, comprising:

a personal information providing means(col. 6, lines 24-55) for providing personal (control word, col. 6, lines 32-37) information to decode a scrambled transport stream;

a descrambling means for descrambling the scrambled transport stream based on the personal information (fig. 22 and col. 35, lines 44-67);

a control information processing means for processing a copy control information (CCI), a broadcasting flag (BF), a retention information (RI), which are storage and playback control information included in the descrambled transport stream, and storing and playing back the broadcasting content (fig. 16, col. 31, lines 13-53);

an encrypting means for encrypting the broadcasting content to be stored (fig. 7, #704 and fig. 3, #327); a storing means for storing the encrypted broadcasting content;

a decrypting means for decrypting the stored broadcasting content; a decoding means for decoding the descrambled and compressed transport stream (col. 32, lines 28-53);

and a playback allowing means for abstracting the CCI, the BF and the RI, which are watermarks, from the decoded transport stream, comparing the abstracted watermark information with the storage and playback control information, and determining whether to allow playback of the broadcasting content (col. 30, lines 58-67, col. 31, lines 1-30).

Regarding claims 6-9, Wasilewski discloses the apparatus as recited in claim 5, wherein the control information processing means changes the CCI included in the transport stream based on the kind of a broadcasting content, when the broadcasting content is stored, wherein the control information processing means checks the BF included in the transport stream based on the kind of a broadcasting content, and stores and plays back the broadcasting wherein the control information processing means checks whether the retention period is valid by checking the RI included in the transport stream based on the kind and service of a broadcasting content, and plays back the broadcasting content, wherein the CCI indicates whether a broadcasting content can be copied and the BF indicates whether the content is an authentic broadcasting content, while the RI indicates retention time of a broadcasting content stored in the hard disk of the receiver (col. 31, lines 13-53 and col. 30, lines 58-67).

Regarding claim 12, Wasilewski discloses an apparatus for storing and playing back digital broadcasting contents, comprising: a control information providing means (col. 6, lines 24-55) for generating control information for recording storage (col. 6, lines 32-37), temporary storage, and playback of a broadcasting content, using the control information as watermarking information (encoding a packet identifier, fig. 7, #709 and col. 32, lines 2-16), multiplexing and scrambling the broadcasting content including the control information (col. 18, lines 36-51), and outputting a scrambled transport; and a storing and playback means for storing the broadcasting content by using the control information, comparing the control information stored together with the broadcasting

content with control information added as watermarks, and determining whether to play back the broadcasting content (col. 30, lines 58-67, col. 31, lines 1-30).

Regarding claim 13, Wasilewski discloses the apparatus as recited in claim 12, wherein the control information includes CCI information for determining whether the broadcasting content can be copied (col. 31, lines 23-24), BF information for determining whether the broadcasting content is an authentic broadcasting content, and RI information for indicating retention time of the broadcasting content stored in a hard disk of the storing and playback means (col. 31, lines 13-53).

Regarding claim 14, Wasilewski discloses the apparatus as recited in claim 12, wherein the control information providing means includes; an access controlling means (col. 6, lines 24-55) for generating access control information for access control service and a control word (col. 6, lines 32-37); a CCI generation means for generating the CCI (col. 31, lines 13-30); a BF generation means for generating the BF (fig. 17, #1705); a RI generation means for generating the RI (col. 31, lines 13-30 and 48-53); a watermarking means for receiving the CCI, the BF, and the RI, and watermarking an uncompressed media signal by using the CCI, the BF, and the RI as watermarks (fig. 7, #709); an encoding means for compressing the watermarked media signal (fig. 7, #704 and fig. 4, #327 and col. 18, lines 52-67); a multiplexing means for receiving and multiplexing the watermarked and compressed media signal, the access control information, the CCI, the BF, and the RI (col. 18, lines 36-51); and a scrambling means for scrambling a

multiplexed transport stream based on the control word and transmitting the scrambled transport stream fig. 7, #704 and fig. 3, #327).

Regarding claim 15, Wasilewski discloses the apparatus as recited in claim 12, wherein the storing and playback means includes: a personal information providing means for providing personal information for decoding the scrambled transport stream; a descrambling means for descrambling the scrambled transport stream based on the personal information; a control information processing means for processing the CCI, the BF and the RI, which are the storage and playback control information included in the descrambled transport stream, and storing and playing back the broadcasting content; an encrypting means for encrypting the broadcasting content to be stored; a storing means for storing the encrypted broadcasting content; a decrypting means for decrypting the stored broadcasting content; a decoding means for decoding the descrambled and compressed transport stream; and a playback allowing means for abstracting the CCI, the BF and the RI, which are watermarks, from the decoded transport streams compares the abstracted watermark information with the storage and playback information, and determining whether to allow playback of the broadcasting content (fig. 22 and col. 35, lines 44-67, fig. 19 and col. 32, lines 28-53).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AUBREY H. WYSZYNSKI whose telephone number is

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(571)272-8155. The examiner can normally be reached on Monday - Thursday, and alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571)272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aubrey H Wyszynski/  
Examiner, Art Unit 2134

/Kambiz Zand/  
Supervisory Patent Examiner, Art Unit 2134